

REMARKS

Claims 1-47 and 49-65 are presently pending in this application. New claim 65 has been added, and claims 1, 10, 11, 22, 25, 26, 29, 31, 33, 34, 37, 38, 40-45, 52, 57 and 61 have been amended in this response to expedite prosecution and without conceding the merits of the rejection of these claims. Several claims, such as claim 18, have not been amended in this response. Therefore, a subsequent rejection of these unamended claims based on new grounds cannot be made final.

In the Office Action mailed May 31, 2005, claims 1-47 and 49-64 were rejected. More specifically, the status of the claims in light of this Office Action is as follows:

- (A) Claims 49-64 were rejected under 35 U.S.C. § 101;
- (B) Claims 1-11, 14, 16-18, 20-45, 49 and 51-64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,938,036 to Villemure ("Villemure") in view of U.S. Patent No. 6,129,346 to Zorn ("Zorn"), U.S. Patent No. 5,407,233 to Wilen ("Wilen"), and U.S. Patent No. 5,367,450 to Pintsov ("Pintsov"); and
- (C) Claims 12, 13, 15, 19, 46, 47 and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Villemure in view of Zorn, Wilen, Pintsov, and U.S. Patent No. 6,421,652 to Loeb et al. ("Loeb").

The undersigned attorney wishes to thank the Examiner for engaging in a telephone conference on September 19, 2005, and further wishes to thank the Examiner and the Examiner's supervisor for engaging in an in-person conference on November 7, 2005. Applicant requests that this paper constitute the applicant's Interview Summary. During the conferences, the present Office Action, the applied art, private labeling, mill branding, and proposed amendments to claims 1, 11, 22, 26, 31 and 34 were discussed. In light of these amendments, the Examiner and the Examiner's supervisor agreed to withdraw (a) the Section 101 rejection of claims 49-64; and (b) the Section 103(a) rejections of claims 1-

64 because the applied art fails to disclose or suggest all the features of these claims. For example, with regard to claim 1, the applied art fails to disclose or suggest a computer system including, *inter alia*, "a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for the paper product." Rather, Villemure discloses an assembly of packaged reams of paper for display at the point of purchase; Zorn discloses an advertising brochure that is mailed with a magazine; Wilen discloses a cover of a magazine with a tear-out portion; Pintsov discloses a method for making a selection of optional enclosures for a mailpiece; and Loeb discloses a method for providing free subscriptions to magazines based on a universal questionnaire.

Applicant submits herewith a Declaration of Commercial Success ("Declaration") describing an increase in sales of cartons of paper to Costco Wholesale Corporation ("Costco") as a direct result of the invention. As described in the Declaration, Grays Harbor Paper ("GHP"), the assignee of the present application, collects remuneration from third-party advertisers who place advertisements on ream wraps in accordance with one embodiment of the invention. Due to the remuneration from advertisers, GHP can reduce the price charged to Costco, which, in turn, can reduce the price charged to consumers. Costco's reduced price increases the volume of paper sold to consumers and, consequently, the volume of paper purchased from GHP. Accordingly, the increased sales to Costco is a direct result of the invention.

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the applied art. The applicant accordingly requests reconsideration of the application and a Notice of Allowance. If the

If Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned representative at (206) 359-6465.

Respectfully submitted,
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Date: November 28, 2005



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